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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/820,590

04/08/2004

Paul Albert Sagel

9031R

8118

27752

7590

05/28/2008

THE PROCTER & GAMBLE COMPANY  
INTELLECTUAL PROPERTY DIVISION - WEST BLDG.  
WINTON HILL BUSINESS CENTER - BOX 412  
6250 CENTER HILL AVENUE  
CINCINNATI, OH 45224

EXAMINER

ROBERTS, LEZAH

ART UNIT

PAPER NUMBER

1612

MAIL DATE

DELIVERY MODE

05/28/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/820,590

**Applicant(s)**

SAGEL ET AL.

**Examiner**

LEZAH W. ROBERTS

**Art Unit**

1612

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 20 February 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3 and 5-23 is/are pending in the application.
- 4a) Of the above claim(s) 13-16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5-12 and 17-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB-08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

This Office Action is in response to the Amendment filed February 20, 2008. All previous rejections have been withdrawn unless stated below.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

### ***Claims***

#### **Claim Rejections - 35 USC § 112 – Indefiniteness (New Rejection)**

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 20 and 21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims recite the limitation "plurality of hours". It cannot be determined what the limitation means because it indicates an amount of time as oppose to matter as indicated by the recitation of "the tooth whitening compositions comprises".

#### **Claim Rejections - 35 USC § 103 – Obviousness (Previous Rejection)**

1) Claims 1-3, 5-8 and 11-12 were rejected under 35 U.S.C. 103(a) as being unpatentable over Godbey et al (US 2002/0187181) in view of Sagel et al. (US 5,891,453). The rejection is maintained.

Applicant's Arguments

Applicant has amended the claims to add the term mixture and to delete subject matter pertaining to the dose of whitening agent. Applicant argues Godbey does not teach a tooth whitening compositions comprising a mixture of a first and second polymer wherein said first polymer is polyethylene oxide and said second polymer is polyvinyl alcohol. The reference does not teach all cold water polymers may be used in the carrier and states certain adhesives may be cold water soluble. One skilled in the art looking at this teaching would not believe that all of the polymers taught as carriers could be used as adhesives and vice versa. Applicant further argues that the combination of an adhesive layer and carrier layer both comprising an active agent does not satisfy the limitation of the whitening composition comprising a mixture of polymers since there appears to be no mixing of the components of the two and that Godbey only considers these compositions to be stable when there is at least no migration of the plasticizer. This argument is not persuasive.

Examiner's Response

In regards to the polymers being in a mixture, the definition of mixture is "A composition of two or more substances that are not chemically combined with each

Art Unit: 1612

other and are capable of being separated"<sup>1</sup>. Applicant has pointed out in their arguments that the two layers comprising each polymer are sandwiched between two polyester support layers. The layers make up one whitening composition product. Therefore the product comprises a mixture of polymers. The claims do not recite that the polymers are a part of the same layer or intermingled with one another. They recite the product comprises a mixture of polymers which is encompassed by Godbey. In regards to new claims 17-23, the backing layer or substrate may be papers, polymeric films, foil or multilayered laminates as recited in Godbey or foil, paper, wovens and non-wovens as recited in Sagel. The compositions may also be made by casting techniques (paragraph 0025).

2) Claims 9-10 were rejected under 35 U.S.C. 103(a) as being unpatentable over Godbey et al (US 2002/0187181) in view of Sagel et al. (US 5,891,453) in further view of Xu et al. (US 2002/0187111). The rejection is maintained.

#### Applicant's Arguments

Applicant argues Godbey and Sagel do not establish a prima facie case of obviousness and Xu does not fill the void in the teachings of the references. The three

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<sup>1</sup> "mixture." *The American Heritage® Dictionary of the English Language, Fourth Edition*. Houghton Mifflin Company, 2004. *Answers.com* 20 May. 2008. <http://www.answers.com/topic/mixture>

Art Unit: 1612

references together fail to establish a prima facie case of obviousness for claim 9 and 10. This argument is not persuasive.

### Examiner's Response

See Examiner's response above in regards to Godbey and Sagel. Xu et al. disclose why one of skill in the art would use mixtures of polyethylene oxides in the compositions of the combined references of Godbey and Sagel. The properties of mixtures of polyethylene oxides provide the compositions with a good balance of cohesive strength and provide the desired rate of release of a whitening agent. Therefore it would have been obvious to add the teachings of Xu et al. to the combined teachings of Godbey and Sagel.

### **Obvious-Type Double Patenting (Previous Rejection)**

Claims 1-12 were provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-12 of copending Application No. 10/936,756. The rejection is maintained in regards to claims 1-3 and 5-12 and further applied to claims 17, 18 and 23.

Applicant argues the two applications are not the same. Applicant is prepared to file a Terminal Disclaimer upon notice of allowable subject matter.

Claims 1-3 and 5-12 are rejected.

Claims 13-16 are withdrawn.

No claims allowed.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LEZAH W. ROBERTS whose telephone number is (571)272-1071. The examiner can normally be reached on 8:30 - 5:00.

Art Unit: 1612

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Frederick F. Krass can be reached on 571-272-0580. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Lezah W Roberts/  
Examiner, Art Unit 1612

/Frederick Krass/  
Supervisory Patent Examiner, Art Unit 1612